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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,000	11/29/2000	Erin M. Bourke-Dunphy	MS160277.1	9642
27195	7590	10/06/2003	EXAMINER	
AMIN & TUROCY, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			GROSS, KENNETH A	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,000

Applicant(s)

BOURKE-DUNPHY ET AL.

Examiner

Kenneth A Gross

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent Number 6,477,703).

In regard to Claim 33, Smith teaches generating a service pack based on system parameters and dependency information (Column 2, lines 1-41).

In regard to Claim 34, Smith teaches: (a) a first component for interrogating a system to identify installed software (Column 2, lines 5-7); (b) a second component for generating a service pack based on system parameters and dependency information (Column 2, lines 14-41).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-14, 17-20, 22-24, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703) in view of Beelitz et al. (U.S. Patent Number 6,182,275).

In regard to Claim 9, Smith teaches: (a) providing dependency information relating to at least one service pack (Column 2, lines 18-20) and (c) selectively installing the service packs associated with an application component according to setup and dependency information (Column 8, lines 18-21). Smith does not teach prompting a user for desired setup information relating to a desired setup for the computer system. Beelitz, however, does teach generating a setup of a computer system based on user input (Column 22, lines 42-52). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide dependency information relating to at least one service pack and selectively install the service packs associated with an application component according to setup and dependency information, as taught by Smith, where the setup information is acquired by prompting a user for desired setup information relating to a desired setup for the computer system, as taught by Beelitz, since this allows service packs to be installed based on the applications that need them.

In regard to Claim 10, Smith and Beelitz teach the method of Claim 9, and Smith does not teach selectively installing at least one application upgrade component in the computer system according to the desired setup information. Beelitz, however, does teach selectively installing at least one application upgrade component in the computer system according to the desired setup information (Column 12, lines 12-14). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 9, as taught by Smith and Beelitz, where an application upgrade component is installed based on

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desired setup information, as taught by Beelitz, since this allows an application upgrade component to be installed based on parameters inputted by the user.

In regard to Claim 11, Smith teaches installing a service pack associated with an application component already installed on the computer system (Column 2, lines 14-17) and when the application component requires the service pack (Column 3, lines 21-25). Beelitz teaches a setup information which indicates application upgrade components to install. The upgrade component that is not to be installed is any upgrade component not on the list of setup information that is associated with the application component.

In regard to Claim 12, Smith teaches installing a service pack associated with an application component already installed on the computer system (Column 2, lines 14-17) and when the application component requires the service pack (Column 3, lines 21-25). Beelitz teaches a setup information which indicates application upgrade components to install. The upgrade component that is to be installed is any upgrade component on the list of setup information that is associated with the application component.

In regard to Claim 17, Smith teaches installing a service pack associated with an application component already installed on the computer system (Column 2, lines 14-17) and when the application component requires the service pack (Column 3, lines 21-25). Beelitz teaches a setup information which indicates application upgrade components to install. The upgrade component that is to be installed is any upgrade component on the list of setup information that is associated with the application component.

In regard to Claim 14, Smith teaches installing an additional service pack that is dependent on the first service pack, and hence associated with the application component

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(Column 2, lines 18-20). Claim 19 corresponds directly with Claim 14, and is rejected under the same logic as Claim 14.

In regard to Claim 22, Beelitz teaches prompting a user for desired setup information relating to a desired setup for the computer system (Column 22, lines 42-52) and installing a service pack associated with a software component residing in a computer system if the software component requires the service pack. Beelitz teaches installing correctional patches, which are obviously required by some applications to fix critical errors (Column 22, lines 42-52). Beelitz further teaches installing a service pack if the setup information indicates that an upgrade component corresponding to a software component is not to be installed. Beelitz teaches a setup information which indicates application upgrade components to install. The upgrade component that is not to be installed is any upgrade component not on the list of setup information that is associated with the application component.

Claims 13, 18, and 23 correspond directly with Claim 10, and are rejected under the same logic as Claim 10.

In regard to Claim 24, Smith teaches not installing a service pack if the software has already been upgrades, and hence the service pack is not required (Column 2, lines 20-23).

In regard to Claims 1-7 and Claims 30-32, Claims 1-7 and Claims 30-32 are system claims, which correspond directly with method claims. Beelitz teaches a user interface (Column 22, lines 37-38), a data store (Figure 1, item 125), and an installation component (Column 28, lines 56-58). Claim 1 corresponds directly with Claim 9. Claim 2 corresponds directly with Claim 11. Claims 3 and 4 correspond directly with Claim 12. Claims 5-7 correspond directly

with Claims 14-16 respectively. Claims 30-32 correspond directly with Claims 22-24 respectively.

In regard to Claims 27-29, Claims 27-29 are medium claims, which correspond directly with method claims. Beelitz teaches a user interface (Column 22, lines 37-38) and an installation component (Column 28, lines 56-58). Claims 27-29 correspond directly with Claims 22-24, respectively.

5. Claims 15, 16, 20, 21, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703) in view of Beelitz et al. (U.S. Patent Number 6,182,275) and further in view of Curtis (U.S. Patent Number 6,442,754).

In regard to Claim 15, Smith and Beelitz teach the method of Claim 14, but do not teach determining the availability of an additional service pack comprises consulting an Internet website. Curtis, however, does teach using a URL to access and download a dependent service pack (Column 10, lines 5-7). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of Claim 14, where determining the availability of an additional service pack comprises consulting an Internet website, as taught by Curtis, since this allows service packs and information to reside in another physical location, and also allows access by multiple users. Claim 20 corresponds directly with Claim 15, and is rejected under the same logic as Claim 15.

In regard to Claim 16, Smith teaches being able to select or deselect service packs for installation (Column 2, lines 32-36). Claims 21, 25, and 26 correspond directly with Claim 16, and are rejected under the same logic as Claim 16.

6. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703).

In regard to Claim 35, Smith teaches generating a service pack based on system parameters and dependency information (Column 2, lines 1-41). Smith does not explicitly teach a data packet comprising the service pack, however, the examiner takes official notice that a service pack is commonly supplied over the Internet and business networks, and is thus, obviously sent in the form of a data packet.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG

  
**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**